



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/660,872

09/11/2003

Hiroshi Kanno

FUJI 20.625

8674

26304 7590 03/20/2008  
KATTEN MUCHIN ROSENMAN LLP  
575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

03/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/660,872 | <b>Applicant(s)</b><br>KANNO ET AL. |  |
|                              | <b>Examiner</b><br>JAGDISH PATEL     | <b>Art Unit</b><br>3693             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 2 are drawn to a settlement system.
  - II. Claim 3 is drawn to a mobile communication terminal configured to communicate with a settlement input device.
  - III. Claim 4 is drawn to a settlement input device.
  - IV. Claim 5 is drawn to a settlement input device.
  - V. Claim 6 is drawn to a settlement device.
  - VI. Claims 7 and 8 are drawn to a settlement device.
  - VII. Claim 9 is drawn to a settlement system.
  - VIII. Claims 10 and 11 are drawn to a mobile communication terminal.
  - IX. Claims 12 and 13 are drawn to a settlement device.
  - X. Claim 14 is drawn to a settlement system.
  - XI. Claim 15 is drawn to a settlement device.
2. Inventions I, VII and X are directed to related systems for settlement of a charge related to input data of purchase items. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed meet each of the aforementioned requirements as follows:

Art Unit: 3693

3. Inventions I VII and X have are not capable of use together and can have materially different design, mode of operation, function or effect and do not overlap in scope, i.e. are mutually exclusive. Invention I has a settlement deice having a control unit which transfers an amount of money determined by the data of the charge from the first account determined by the identification data of the mobile Communication terminal received from the settlement input device to the second account determined by the identification data of the settlement input device. Invention VII has a settlement device having a control unit configured to compare the data of the charge from the settlement input device and the data f the charge from the mobile communication terminal transfer an amount of money determined by the data of the charge from the first account determined by the identification data of the mobile communication terminal received from the settlement input device to the second account determined by the identification data of the settlement input device at least when the data of the charge from the settlement input device and the data of the charge from the mobile communication terminal are in agreement. Invention X has a settlement device having a control unit configured to compare the data of the charge from the settlement input device and the data of the charge from the mobile communication terminal transfer the amount of money determined by the data of the charge from the first account determined by the identification data of the mobile communication terminal to the predetermined account.

Invention II (claim 3) is a subcombination distinct from combinations I, VII and X.

4. Inventions II and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that

Art Unit: 3693

the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, none of the combinations as claimed require the particulars of the subcombination as claimed such as a mobile communication terminal having a control unit that is configured to generate identification data for a purchase transaction which varies with different purchase transactions according to a predetermined rule. This feature of the mobile communication terminal is not required by the settlement systems of inventions recited in combinations I, VII and X. Furthermore, the subcombination has a utility by itself that of generating identification data for a purchase transaction which varies according to a predetermined rule.

Invention III (claim 4) is a subcombination distinct from combinations I, VII and X.

5. Inventions III and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, none of the combinations as claimed require the particulars of the subcombination as claimed such as a settlement input device having **an input unit configured to input data of purchased items and identification data of the mobile communication terminal**. This feature of the mobile communication terminal is not required by the settlement systems of inventions recited in combinations I, VII and X. On the other hand the settlement input device has utility by itself or other combinations such as inputting input data of purchased items and sending it to an identified mobile communication terminal.

Invention IV (claim 5) is a subcombination distinct from combinations I, VII and X.

Art Unit: 3693

6. Inventions IV and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the none of the combinations as claimed require the particulars of the subcombination as claimed such as a settlement input device having **a second reception unit configured to receive a determination result for the identification data of the purchase transaction and a display for displaying the determination result whether the received identification data of the purchase transaction satisfy a predetermined rule relative to stored identification data of a previous purchase transaction.** On the other hand the settlement input device has utility by itself or other combinations such as receiving and displaying a determination result concerning a purchase transaction.

Invention V (claim 6) is a subcombination distinct from combinations I, VII and X.

7. Inventions V and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, none of the combinations as claimed require the particulars of the subcombination as claimed such as a settlement device having **a reception unit configured to receive from the settlement input device the**

Art Unit: 3693

**data of the charge, the identification data of the mobile communication terminal, and the identification data of the settlement input device.** On the other hand the settlement device has utility by itself or other combinations such as receiving data of the charge from a settlement input device the data of the charge, the identification data of the mobile communication terminal, and the identification data of the settlement input device.

Invention VI (claims 7 and 8) is a subcombination distinct from combinations I, VII and X.

Inventions VI and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the none of the combinations as claimed require the particulars of the subcombination as claimed such as a Communication terminal having a storage unit configured to store at least identification data of a previous purchase transaction made by the mobile communication terminal and a control unit and a control unit configured to transfer an amount of money based on the identification data of the previous purchase transaction based on a determination that the identification data of the purchase transaction received from the settlement input device satisfies a predetermined rule. The communication terminal has utility by itself or other combinations such as transferring an amount of money based on the identification data of the previous purchase transaction, and determination that the

Art Unit: 3693

identification data of the purchase transaction received from the settlement input device satisfies a predetermined rule.

Invention VIII (claims 10 and 11) is a subcombination distinct from combinations I, VII and X.

Inventions VIII and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the none of the combinations as claimed require the particulars of the subcombination as claimed such as a mobile communication terminal having at least an input unit and a transmit unit wherein the transmission unit configured to transmit the received data of the charge to the settlement device through a mobile communication network in response to the input data from the input unit. This feature of the mobile communication terminal is not required by the settlement systems of inventions recited in combinations I, VII and X. Furthermore, the subcombination has a utility by itself that of transmitting the received data of the charge to the settlement device through a mobile communication network in response to the input data from the input unit.

Invention IX (claims 12 and 13) is a subcombination distinct from combinations I, VII and X.

Inventions IX (claims 12 and 13) and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the



Art Unit: 3693

combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the none of the combinations as claimed require the particulars of the subcombination as claimed such as a settlement device having a control unit configured to compare the data of the charge from the settlement input device and the data of the charge from the mobile communication terminal, and transfer an amount of money determined by the data of the charge from the first account determined by the identification data of the mobile communication terminal received from the settlement input device to the second account determined by the identification data of the settlement input device at least when the data of the charge from the settlement input device and the data of the charge from the mobile communication terminal are in agreement. The subcombination has utility by itself or other combinations such as comparing the data of the charge from the settlement input device and the data of the charge from the mobile communication terminal and based the result of the comparison transferring an amount of money.

Invention X (claim 15) is a subcombination distinct from combinations I, VII and X. Inventions IX and inventions I, VII and X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the none of the combinations as claimed require the particulars of the subcombination as claimed such as a settlement device having a control unit configured to transfer an amount of money determined by the data of the charge from a predetermined

Art Unit: 3693

account to the second account determined by the identification data of the settlement input device at least when the data of the charge, identification data of the mobile communication terminal, and identification data of the settlement input device are received from the settlement input device, no matter whether the data of the charge are received or not from the mobile communication terminal, and to transfer the amount of money determined by the data of the charge from the first account determined by the identification data of the mobile communication terminal to the predetermined account at least when the data of the charge are received from the mobile communication terminal. The settlement device has utility by itself or other combinations such as transferring an amount of money from a predetermined account to the second account when the data of the charge, identification data of the mobile communication terminal, and identification data of the settlement input device are received from the settlement input device, no matter whether the data of the charge are received or not from the mobile communication terminal.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

8. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. No telephone interview was conducted due to complexity of the restriction requirement and since the examiner knows from past experience that an election is seldom made by telephone. (see MPEP 812.01)

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693